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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/819,244	03/28/2001	Satoru Ueda	450100-03099	2106
20999 7590 07/02/2008 FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL.. NEW YORK, NY 10151				
EXAMINER				
STRANGE, AARON N				
ART UNIT		PAPER NUMBER		
2153				
MAIL DATE		DELIVERY MODE		
07/02/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/819,244

Applicant(s)

UEDA, SATORU

Examiner

AARON STRANGE

Art Unit

2153

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- 7) ☐ Paper No(s)/Mail Date: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 3/28/08 have been fully considered but they are not persuasive.
2. Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. Applicant has merely cited a very large portion of claim 1 accompanied with the general assertion that the prior art of record fails to teach the numerous cited features. The Examiner respectfully disagrees, and the claims have been rejected below.

Claim Objections

3. Claims 1 and 9 objected to because of the following informalities:
 - a. Claim 1 appears to contain a typographical error "an attorney terminal is routed" in lines 22-24.
 - b. Claim 1 appears to contain a typographical error "system[comma][period]" in line 46.
 - c. The preamble of claim 9 is unclear and appears to have numerous typographical errors. The Examiner recommends amending the preamble to state "A computer-readable recording medium having recorded therein an

executable program, which when executed, causes a computer to certify an electronic mail ..."

Appropriate correction is required. Applicant is also encouraged to carefully review the claims to identify any other typographical errors that may have been overlooked by the Examiner.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Claim 1 recites the limitations "the identification" and "the password" in lines 28-29. There is insufficient antecedent basis for these limitations in the claim.

7. With regard to claim 7, the limitation "an electronic mail" in line 5 is unclear. It is unclear if this is the same electronic mail as the electronic mail recited in the preamble. If so, the Examiner recommends amending the claim to recite "[said/the] electronic mail". If not, the Examiner recommends amending the claim to recite "a second electronic mail" or a similar limitation.

8. All claims not individually rejected are rejected by virtue of their dependency from the above claims.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ng (US 6,640,301) in view of Zabetian et al. (6,327,656) further in view of Borwankar (US 6,594,693) further in view of Official Notice.

11. With regard to claim 1, Ng discloses a communication contents certification system for certifying contents of an electronic mail, comprising:

a communication contents certification apparatus (Email web site) (Fig 4, 20') comprising: communication contents receiving means for receiving said electronic mail (messages are received through email web site) (Col 6, Lines 42-46), communication contents storage means for storing the contents of said electronic mail (Copies of sent email can be stored at the email web site) (Col 8, Lines 40-42), communication contents transmission means for transmitting said electronic mail (Messages are sent through

email web site) (Col 6, Lines 42-46), and charging means for charging a fee associated with use of the communication contents certification apparatus (Col 14, Lines 21-26);

a first party communication terminal coupled to the communication contents certification apparatus (terminal containing browser) (Fig 4, 24) (Col 6, Lines 41-58);

a second party communication terminal coupled to the communication contents certification apparatus (terminal containing email client) (Fig 4, 15) (Col 6, Lines 41-58);

a first attorney communication terminal coupled to the communication contents certification apparatus (Col 13, Lines 62-65);

a second attorney communication terminal coupled to the communication contents certification apparatus (Col 13, Lines 62-65); wherein:

wherein the electronic mail is transmitted from a first party communication terminal or an attorney terminal and is routed to the communication contents certification apparatus that stores the contents of the electronic mail (email is sent via the certification apparatus) (Col 8, Lines 19-29), and

wherein a reply message in response to a received electronic mail is prepared for the electronic mail transmission (at least Col 10, Lines 25-27; Fig 8D).

Ng fails to specifically disclose sending a confirmation message from the receiving terminal through the certifying apparatus, obtaining an identification and password of a sending party to authenticate the contents of the electronic mail, preparing a reply message with reference to a comment provided from one of the attorney communication terminals, charging means for charging at least one of the parties for authenticating and/or certifying the contents of the electronic mail, storing the

communication history of the electronic mail, or forming a contract for using the system between the first and second parties prior to transmitting a certified transmission..

Zabetian discloses a similar system for certifying electronic mail and teaches authenticating the electronic mail based on an identification (source address) (Col 6, Lines 38-45) and password of the sending party (Col 6, Lines 63-64). Zabetian further teaches billing a user of the system (Col 6, Lines 45-49) and the first and second users forming a contract for using the system prior to transmitting any certified messages (users register with the system, prior to use, in order to be identified)(col. 6, ll. 38-42, 54-67). Zabetian further teaches sending a confirmation message to the sender of a message (Col 11, Line 63 to Col 12, Line 3). These would have been advantageous additions to the system disclosed by Ng since they would have allowed the sender of the message to be positively identified, ensuring that the message actually came from a particular person, and allowing that use to be billed for using the system, and also allowed senders to be notified that sent messages were actually received by the intended recipients.

Bonwankar also discloses a similar system for sending electronic mails between persons on a network and teaches storing the communication history of the electronic mails (at least Col 3, Lines 56-60). This would have been an advantageous addition to the system disclosed by Ng and Zabetian since it would have allowed users to save their messages and access them at a later time to see desired portions of their conversation.

The Examiner takes Official Notice that charging a fee for services rendered to a user is old and well-known in the art, and that it would have been apparent to one of ordinary skill in the art at the time the invention was made to charge a sender or receiver a fee for authenticating and/or certifying an electronic mail depending on various factors such as storage organization, storage method, frequency of backup, storage size, or any number of additional criteria corresponding to the expenses incurred by the service provider in providing the service. Furthermore, both Ng (Col 14, Lines 22-25) and Zabetian (Col 6, Lines 45-49) suggest charging fees for various aspects of their services, and one of ordinary skill in the art would have recognized the advantages of fee collection for cost recovery and profit.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the various teachings of Ng, Zabetian and Bonwankar to arrive at the claimed invention.

With regard to the limitation "wherein the communication contents certification apparatus is owned by another party independent from the two or more parties", it is noted that ownership is not a structural limitation of a system. A change in ownership will not result in a physical change of an apparatus. Therefore, this limitation fails to impart any patentable weight to the claimed system.

While Ng fails to specifically disclose preparing the reply message with reference to a comment provided from one of the attorney communication terminals, the content of the messages sent and received via the system is nothing more than non-functional descriptive material. Nonfunctional descriptive material cannot render nonobvious an

invention that would have otherwise been obvious. *In re Ngai*, 367 F.3d 1336, 1339, 70 USPQ2d 1862, 1864 (Fed. Cir. 2004). *Cf. In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability). In this case, the difference between the prior art and the claimed invention is simply a rearrangement of nonfunctional descriptive material, which is presumed to be well within the level of ordinary skill in the art at the time the invention was made. *See Ex Parte Curry*, Appeal No. 2005-0509 (Appl. No. 09/449,237) (*aff'd*, Appeal No. 06-1003 (Fed. Cir. Jun. 12, 2006)(Rule 36)(unpublished)).

12. With regard to claim 2, while the system disclosed by Ng shows substantial features of the claimed invention (discussed above), including a GUI (Col 8, Lines 20-22), a party button display section for selecting electronic mail communication with the second party communication terminal wherein the first party communication terminal is adapted to transmit the electronic mail as a function of input to the GUI (Clicking on "Authenticated Send" button sends message to second party via certification apparatus)(Col 8, Lines 25-29), it fails to specifically disclose an attorney button display section for selecting electronic mail communication with said first attorney communication terminal.

However, at the time the invention was made, it would have been obvious to one of ordinary skill in the art to include an attorney button display because Applicant has not disclosed that a dedicated attorney button display provides an advantage, is used

for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well by specifying the attorney's email address and using the "Authenticated Send" button as disclosed by Ng (Col 8, Lines 19-29 and Fig 8A-8D) because both methods perform the required task of sending the message to the user's attorney via the certification apparatus equally well.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system disclosed by Ng to obtain the invention as specified in claim 2.

13. With regard to claim 3, Ng further discloses that the contents of the electronic mail relate to a contract matter (Terms of Sale) between said first party and said second party (Fig 8A-8D).

14. With regard to claim 4, Zabetian further discloses a method of confirming the reception of an electronic mail by having the recipient notify the certification requester (the certification apparatus in this case) upon successful receipt of the message. Zabetian discloses that this can be accomplished through a conventional return receipt or through an active login procedure to the email web site (Col 11, Line 63 to Col 12, Line 16).

15. With regard to claim 5, Ng further discloses that the electronic is encrypted (Col 14, Lines 45-47).

16. With regard to claim 6, Zabetian further discloses several methods of registering users for email service so their identity can be confirmed (Col 6, Line 54 to Col 7, Line 3).

17. Claims 7 and 8 are rejected for the same reasons as claims 1 and 3, since they recite subject matter which is wholly contained within those claims.

18. Claim 9 is rejected for the same reasons as claim 1, since it recites subject matter which is wholly contained within claim 1. Since the system disclosed by Ng is executed on computers, a computer readable recording medium holding the software to perform the method of claim 9 is inherent.

Conclusion

19. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to AARON STRANGE whose telephone number is (571)272-3959. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on 571-272-3949. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Art Unit: 2153

/Glenton B. Burgess/

Supervisory Patent Examiner, Art Unit 2153

/A. S./

Examiner, Art Unit 2153